

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT KUNIN

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Appeal No. 94-1545  
Application 07/939,990<sup>1</sup>

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH and GRON, Administrative Patent Judges.

GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal of an examiner's final rejections of  
Claims 1-7, all claims pending in this application.

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<sup>1</sup> Application for patent filed September 3, 1992.  
According to applicant, this application is a continuation-in-part  
of Application 07/737,705, filed July 30, 1991, now abandoned.

Appeal No. 94-1545  
Application 07/939,990

Claim 2 stands rejected under 35 U.S.C. § 112, fourth paragraph. Appellant concedes that this rejection is proper (Appeal Brief, page 4). Therefore, we affirm the examiner's rejection of Claim 2 under § 112.

Claims 1-7 stand rejected under 35 U.S.C. § 102 as anticipated by Ghebre-Sellassie et al. (Ghebre-Sellassie), U.S. 4,814,354, patented March 21, 1989. For the rejection under this section, all claims stand or fall together (Appeal Brief, page 4). We reverse the examiner's rejection of Claims 1-7 under § 102.

#### Discussion

Claim 1 is representative of the claimed subject matter and reads:

1. A salt comprising the reaction product of nicotinic acid and a basic anion exchange resin having a degree of crosslinking with divinylbenzene of less than about 4%, a maximum degree of crosslinking corresponding to a minimum moisture content of 50%, and a particle size in water in a swollen, chloride form ranging from about 0.03 to about 0.84 mm.

To sustain an examiner's rejection under 35 U.S.C. § 102, a prior art reference must itself sufficiently describe the claimed invention to have placed a person having ordinary skill in the art in possession of it. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). We hold that the examiner clearly erred in finding that Ghebre-Sellassie placed the

Appeal No. 94-1545  
Application 07/939,990

invention appellant claims in the possession of the public.

Appellant claims a salt, i.e., a reaction product of an acid with a base. The acid is nicotinic acid. The base is a basic anion exchange resin crosslinked to a specified degree with divinylbenzene. While the crosslinking limitations of the basic anion exchange resin reactant are not apparent from Ghebre-Sellassie's general description of cholestyramine, i.e., a pharmaceutically important anionic-exchange resin including "basic quaternary ammonium-exchange functionalities . . . attached to a styrene divinylbenzene copolymer skeleton" (col. 2, lines 63-66) having the structure depicted at column 3, lines 1-10, appellant does not challenge the examiner's inference that the basic anion exchange resin reactant described by Ghebre-Sellassie is either identical to or substantially the same as the basic anion exchange resin reactant of appellant's salt.

Nor does the appellant deny that Ghebre-Sellassie teaches that cholestyramine and nicotinic acid are both known lipid lowering/regulating agents (col. 3, lines 12-25 and 40-50) and contemplates formulations comprising cholestyramine and other lipid modifiers, one of which may be nicotinic acid (col. 3, lines 33-50). Rather appellant argues that Ghebre-Sellassie's invention is directed to pharmaceutical compositions comprising (1) a basic anion exchange resin lipid regulator which is coated

Appeal No. 94-1545  
Application 07/939,990

with a pharmaceutically acceptable acid resistant enteric phthalate soluble in intestinal juice of the small intestine, and (2) an acidic lipid regulator, e.g., gemfibrozil (Ghebre-Sellassie, col. 6, Claim 1).

We find that the inventive compositions Ghebre-Sellassie describes are not reaction products at all. In fact, Ghebre-Sellassie coats the basic anion exchange resin lipid regulator for the express purpose of preventing a salt-forming reaction between the basic anion exchange resin lipid regulator and other known acidic lipid regulators, e.g., gemfibrozil and nicotinic acid. Ghebre-Sellassie teaches that salt-forming reactions reduce the pharmaceutical efficacy of the individual regulators (col. 1, lines 61 to 65):

Furthermore, the coating process used in the pretreatment virtually assures that the cholestyramine or other ionic component will not react to any significant extent before it reaches the proper location in the gastrointestinal tract so that its efficacy is maximized (emphasis added).

Thus, Ghebre-Sellassie actually teaches away from the salt appellant claims. However, teaching away from the claimed invention is pertinent to determinations of patentability under 35 U.S.C. § 103, not findings of anticipation under § 102.

Nevertheless, why the examiner cannot understand that a salt is the reaction product of an acid and a base escapes us. While

Appeal No. 94-1545  
Application 07/939,990

we find that Ghebre-Sellassie compares the amount of gemfibrozil which binds to treated cholestyramine at pH 4.5-7.5 (Table II) to amount of gemfibrozil which binds to untreated cholestyramine at the same pH (Table I), we find that Ghebre-Sellassie does not sufficiently describe a salt of nicotinic acid and untreated cholestyramine to have placed it in the possession of the public.

#### Conclusion

1. The rejection of Claim 2 under 35 U.S.C. § 112, fourth paragraph, is affirmed.

2. The rejection of Claims 1-7 under 35 U.S.C. § 102 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

#### AFFIRMED-IN-PART

Sherman D. Winters	)	
Administrative Patent Judge	)	
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William F. Smith	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES

Appeal No. 94-1545  
Application 07/939,990

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Appeal No. 94-1545  
Application 07/939,990

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